

REMARKS

Upon review of the pending Office Action, reconsideration is respectfully requested. Nonetheless, in light of the positions presented herein, this application is believed to be in condition for allowance.

The Action discusses election of a single species for purpose of initial prosecution. The referenced telephone conversation is not recalled as making such an election, provisionally or otherwise. Nonetheless, Applicants are agreeable to continue this examination with the species recited at the top page 5 of the Action.

Several claims were rejected under 35 U.S.C. § 102 as anticipated by Kinder. Responsive thereto, claims 1 and 10 are hereby amended. Applicants respectfully disagree with the Examiner's position regarding claims 28-34. To expedite disposition of this application, such claims are hereby cancelled and will be pursued by way of a continuation application. Accordingly, the rejection should be withdrawn, with the subject claims allowed to proceed toward issue.

Several claims were also rejected under 35 U.S.C. § 103 as obvious over Kinder. Applicants appreciate the Examiner's concern, but respectfully disagree. The Kinder compounds were designed to provide amino acid and dipeptide analogs as transition state inhibitors of the serine proteases α -chymotrypsin and elastase. Quite contrary thereto, Applicants' compounds were found to be lactamase inhibitors. The diametric divergence from Kinder is illustrated in the present specification on page 21, with reference to Table 5. Non-limiting, representative compounds of the present invention were tested against the serine proteases and found to be, by 3 to 5 orders of magnitude, selective for lactamase AmpC. Such markedly divergent properties show there is no motivation to structurally modify the Kinder compounds. Without motivation, there is no *prima facie* obviousness.

The Examiner notes that the Kinder compounds were prepared using the same general synthetic strategy employed by Applicants. Without more, the Examiner is suggesting that it would be obvious to try substituents not disclosed or suggested in Kinder to provide Applicants' compounds. However, "obvious to try," is not motivation to do what Applicants have done. Again, there is no *prima facie* obviousness. The rejection should be withdrawn, with the subject claims allowed to proceed toward issue.

This application is believed to be in condition for allowance. Consistent therewith, favorable action is respectfully requested. The Examiner is invited to contact the undersigned by telephone if any issue remain. Thank you for your time and consideration.

Respectfully submitted:



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